

Appl. No. 09/905,269

Attorney Docket: 042390.P12059

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated March 08, 2005, in which:

- the Applicants are required, under 35 U.S.C. § 121, to elect a single disclosed species for prosecution on the merits.

The PTO has asserted that the following are distinct species of the claimed invention:

- Species 1: claims 1-13, and 47-60;
- Species 2: claims 14-27; and
- Species 3: claims 28-46.

Reconsideration of the above referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-13 and 47-73 are now pending the above referenced patent application. Claims 1-13 and 47-60 have been elected. No claims have been amended. Claims 14-46 have been canceled; however, Applicants intend to pursue the cancelled claims to issuance in separate divisional patent application (to be filed). Therefore, no prosecution history estoppel or change in scope of the claims should result from the foregoing cancellations. Claims 61-73 have been added. No new matter has been entered.

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1. 35 U.S.C. § 121

M.P.E.P. § 803 sets forth both the standard of a *prima facie* case of § 121 restriction and the burden of proof for making the *prima facie* case.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

GUIDELINES

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.

Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. In *re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02

Although the Applicants do not believe the restriction requirement is proper, nonetheless, Applicants elect to prosecute species 1, claims 1-13 and 47-60.

The non-elected claims, Claims 14-46, have been canceled; however, Applicants intend to pursue the cancelled claims to issuance in separate divisional patent application (to be filed). Therefore, no prosecution history estoppel or change in scope of the claims should result from the foregoing cancellations.

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CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,



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